APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,984	11/03/2003	Taku Aida	SONYJP 3.0-346	5312

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LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

EXAMINER
JOHNS, CHRISTOPHER C

ART UNIT	PAPER NUMBER
3621	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/699,984	AIDA ET AL.
	Examiner	Art Unit	
	Christopher C. Johns	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _11 February 2010_.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1,6 and 19_ is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1,6 and 19_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Acknowledgements

1.   This Office Action is given Paper No. 20100430 for reference purposes only.

2.   This Office Action is in response to the Response to Non-Final Rejection, filed by

Applicants on 11 February 2010.

3.   Claims 1, 6, and 19 are pending.

4.   Claims 1, 6, and 19 have been examined.

Claim Objections

5.   Claims 1, 6, and 19 are objected to because of the following informalities: they are not in

compliance with 37 CFR §1.75(i), which requires that claims with "a plurality of elements or

steps" have each element or step "separated by a line indentation." Appropriate correction is

required.

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

7.   Claims 1, 6, and 19 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S.

Patent 6,732,106 ("Okamoto").

8.   As per claim 1, Okamoto discloses:

9.   a system for providing software (figure 10 generally);

10.   a server (figure 10, Distribution server **1001**) programmed to provide software (figure 10,

Distributed digital data storage means **1009**) via a network (figure 10, arrow between sending

and receiving means **1014** and communication means **1015**) in response to a request to purchase

or transfer the same (figure 26, User selects digital data to download **S2608**);

11.   at least two electronic devices (figure 10, User device **1002**), each of the at least two

electronic devices being identified by device identification information (figure 10, Device ID

1021) registered in association with user identification (figure 14, User ID...Device ID; the User

ID and Device ID columns have associated records) information identifying a single user (figure

14, User ID; e.g. "AA00001") such that each of the at least two electronic devices have the same

user associated therewith (figure 14, "SD Card adapter", "Portable phone");

12.   each of the at least two electronic devices including a first central processing unit (figure

10, User device **1002** inherently contains a central processing unit, because this is inherently how

computers operate) to cause the user identification information (figure 21, Log-in process **S2104**)

and the device identification information for the respective electronic device (figure 26, sends

their device IDs to server **S2609**), and software identification information for selected software

(figure 25, user selects digital data to be selected **S2503**), to be sent to the server to request that

the selected software be provided (the communications in **S2104**, **S2503**, and **S2609** all send data

to the server);

13.   to cause the selected software provided from the server to be installed (figure 26, Storage

media writing process **S2617**) after the user identification information and the device

identification information for the respective electronic device, and the software identification

information for the selected software, has been sent to the server (the communications in **S2104**,

S2503, and **S2609** all take place before **S2617** takes place);

14.   to cause the selected software to be run using the license (figure 10, storage media **1022**);

15.   to cause information to be supplied to the respective electronic device (figure 26, Display

valid devices **S2611**) which identifies each electronic device currently available to receive the

selected software by transfer if a request to do so is made (the "valid devices" are "registered"

devices as in **S2610**);

16.   to cause a request that the server transfer the selected software from the respective

electronic device to another of the at least two electronic devices (figure 26, User selects

download location **S2612**) which has the same user associated therewith as that of the respective

electronic device and which is selected by use of the information which identifies said each

electronic device currently available to receive the selected software by transfer (figure 8,

"Choose a download device");

17.   the server including a second central processing unit (figure 10, Distribution server **1001**

inherently contains a central processing unit, because this is inherently how computers operate)

to cause registration of the software identification (figure 18, "Rights ID" and "Contents ID"

identify the content associated with the "User ID") information for the selected software in

association with the user identification information (figure 20, "User ID") and the device

identification information (figure 20, "System name") for the respective electronic device on

condition that the user identification information and the device identification information for the

respective electronic device have been registered in association with each other (figure 20);

18.   to cause the selected software to be provided to the respective electronic device (figure

10, Digital data distribution means **1013**);

19.   to cause generation of the license when the software identification information, the user

identification information, and the device identification information for the respective electronic

device have been registered in association with each other (figure 26, digital data in **S2601** is

matched with the valid devices in **S2610**, which are checked for association with users in

S2610);

20.   to cause, upon a request by the respective electronic device to transfer the selected

software to the another electronic device (figure 26, Display a list of digital data **S2607**), the

information to be provided which identifies said each electronic device currently available to

receive the selected software by transfer to the respective electronic device to enable a selection

(figure 26, Display valid devices **S2611**);

21.   the software identification information for the selected software and the user

identification information and the device identification information registered in association with

the software identification information for the respective electronic device to be deleted (figure

31, Delete old device information **S3112**);

22.   the software identification information for the selected software to be registered in

association with the device identification information for the another electronic device and the

user identification information, such that the respective electronic device is prohibited from

purchasing software (figure 31, Delete old device information **S3112**) and such that the another

electronic device is allowed to run the selected software (figure 31, User selects device to be

registered **S3111**).

23.   Okamoto does not explicitly disclose:

24.   to cause the software identification information for the installed software, the user

identification information, and the device identification information for the respective electronic

device to be sent to the server so as to request that a license required to run the selected software

be generated based on predetermined license generating information and be provided to the

electronic device.

25.   However, it would have been obvious to one of ordinary skill in the art at the time of the

invention to modify Okamoto to include separate steps for performing similar (as well as highly-

interwoven) functionality. It is the Examiner's finding and position that absent evidence of new

or unexpected results, it is not inventive in terms of patentability to take one or more steps (S_1,

S_2, S_3,... S_N) which perform one or more tasks (T_1, T_2, T_3, ...T_N) and add (or subtract) an

additional number of steps (X) to perform all or part of the same tasks by allocating the tasks

between the various steps (i.e. S_1 performs the 1st part of T_1; S_2 performs the 2nd part of T_1; ...

while S_N performs the first part of T_N and S_{N+1} performs the 2nd part of T_N). The prior art is

replete with examples showing why user various client server configurations are desirable[1].

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[1] See e.g. Watson (United States Patent 6,223,209 B1) disclosing distributed satellite world wide
web servers containing identical information placed strategically throughout the Internet so as to
be close to all potential clients to help reduce traffic bottlenecks; Midgely et. al. (United States
Patent 5,592,611 A) disclosing additional servers as a stand-in for a failed server so that client
service requests are transparent to the user; Kriegsman (United States Patent 6,370,580 B2)
disclosing multiple servers as secondary web severs to optimize file transfers; Burns et. al.
(United States Patent 6,298,373 B1) disclosing cache servers which download content during
off-peak hours to reduce traffic bottlenecks; Stiles (United States Patent 6,219,692 B1) which
discloses sending essentially identical tasks to multiple servers with differing processing loads to
find the most preferred server provider; Zdepski et. al. (United States Patent 5,825,884)
disclosing an transactional server for TV networks; Burns et. al. (United States Patent 6,298,373)

26.   In other words, a modification distributing the tasks between various steps (*e.g.* having

multiple steps perform the actions previously performed by a single step) is analogous to making

functionality or actions separable. In this exact situation, it would have been obvious to one of

ordinary skill in the art at the time of the invention to split the step of acquiring the digital

content and the license into two steps. This would create a more convenient system for its users;

by accomplishing the acquisitions in two separate steps, the failure of either step would not

require a complete rerunning of the full step - instead, only the half-step (either acquiring the

license or acquiring the data) would be necessary. This would create a more convenient system

for its users, leading to a more profitable system for its creators because users are more likely to

buy and use a convenient system.

27.   Therefore, it is the Examiner's position that when the difference between the claimed

invention and the prior art is that the prior art does not explicitly disclose an element as

separable, then as a matter of law, it would have been obvious to one of ordinary skill in the art

at the time of the invention to make the element separable. See also *In re Dulberg*, 289 F.2d

522, 523, 129 USPQ 348, 349 (CCPA 1961), and MPEP §2144.04. In the instant case, it would

also have been obvious to one of ordinary skill in the art at the time of the invention to split the

one step of acquiring the license and data into two steps, in order to create a more convenient

(for its user) and profitable (for its creators) system.

28.   Claims 6 and 19 are substantially similar to claim 1, and are therefore similarly rejected.

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disclosing how computers are used at clients to increase bandwidth by providing content in
downloaded from other computers; How Networks Work (2000, ISBN: 0789724456, Derfler et

Claim Interpretation

29.   The Examiner hereby adopts the following definitions under the broadest reasonable

interpretation standard. In accordance with *In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023,

1029 (Fed. Cir. 1997), the Examiner points to these other sources to support his interpretation of

the claims. Additionally, these definitions are only a guide to claim terminology since claim

terms must be interpreted in context of the surrounding claim language. Finally, the following

list is not intended to be exhaustive in any way:

30.   *Allow*: "3 b : to forbear or neglect to restrain or prevent." Webster's Ninth New

Collegiate Dictionary, Merriam-Webster Inc., Springfield MA, 1986.

31.   *Device*: "A generic term for a computer subsystem." Computer Dictionary, 3rd Edition,

Microsoft Press, Redmond, WA, 1997.

32.   *For*: "1 a -- used as a function word to indicate purpose... b -- used as a function word to

indicate an intended goal" Webster's Ninth New Collegiate Dictionary, Merriam-Webster Inc.,

Springfield MA, 1986.

33.   *Method*: "a way of doing something, especially an ordered set of procedures or an

orderly system." Chambers 21ˢᵗ Century Dictionary, Chambers Harrap Publishers, London, UK,

2001.

34.   *Operable*: "1 : fit, possible, or desirable to use." Webster's Ninth New Collegiate

Dictionary, Merriam-Webster Inc., Springfield, M.A. 1986.

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al), Chapter 17 describing how server based structures benefit from economies of scale in
addition to offering security, excellent data management, fast response, and room for expansion.

35.   *To*: "2a -- used as a function word to indicate purpose, intention, tendency, result, or

end." Webster's Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield MA, 1986.

Response to Arguments

36.   Applicants' arguments, filed 11 February 2010, have been considered but are not

persuasive.

37.   **Applicants argue**: "It should be noted that in between these two features, the software

may be actually installed in the respective electronic device...it is respectfully submitted that

Okamoto as applied by the Examiner does not appear to disclose such features as not specifically

recited in claim 1" (remarks, page 10, ¶2).

38.   **Examiner's response**: The Examiner disagrees. Okamoto teaches installing the software

on the requested electronic device.

39.   The Examiner finds that the storage media **1022** is installed inside of the electronic

device - see figure 10, where it is clear that storage media **1022** is part of User device **1002**.

40.   The Examiner finds that figure 26, Storage media writing process **S2617** is the step of

figure 26 where the digital data is actually installed to the storage media **1022**.

41.   Because the digital data is installed to the storage media **1022**, and because the storage

media **1022** is connected to and part of the User device **1002**, the "software [is] actually installed

in the respective electronic device." Because the software is installed in the electronic device,

Applicants' arguments, while fully considered, are not persuasive.

Conclusion

42.   **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time

policy as set forth in 37 C.F.R. § 1.136(a).

43.   A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R.

§ 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

will the statutory period for reply expire later than SIX MONTHS from the date of this final

action.

44.   Any inquiry concerning this communication or earlier communications from the

Examiner should be directed to Christopher C. Johns whose telephone number is (571)270-3462.

The Examiner can normally be reached on Monday - Friday, 9 am to 5 pm.

45.   If attempts to reach the Examiner by telephone are unsuccessful, the examiner's

supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

46.   Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher C Johns/
Examiner, Art Unit 3621

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621